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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,014	02/28/2002	Andrea Hughs-Baird	0112300-610	3796
29159	7590	04/21/2005	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			MOSSER, ROBERT E	
			ART UNIT	PAPER NUMBER

3714

DATE MAILED: 04/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/086,014

Applicant(s)

HUGHS-BAIRD ET AL.

Examiner

Robert Mosser

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 June 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18, 20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18, 20 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6-01-2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**



**This action is final.**

**Claims 1-18 and 20-21 are pending.**

**The IDS submitted 6-1-2004 is attached**



***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 11, 18, and 21 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over at least claim 18 of U.S. Patent No. 6,648,754. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are substantially similar to those of Baerlocher et al with following two exceptions.

First, Baerlocher refers to the awarding of a number of steps while the applicant instead refers to the awarding of a value. As the "value " awarded in the instant

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application would so encompass a number of steps as presented in the patented application the terms are understood as equivalent. It would be obvious to one of ordinary skill in the art at the time of invention to award a value or step with associated game value equivalently for the purposes of addressing game theme issues.

Second the claims of Baerlocher are silent regarding the reshuffling or re-introduction of player rejected offers into a pool of available offers however the examiner gives official notice that the re-introduction of discarded player selections is extremely old and well known in the art of gaming. It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated reshuffling or re-introduction of player rejected offers into the game of Baerlocher in order to ensure that in a fixed set of selectable options the odds of choosing a particular option remain consistent through multiple player selections.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7-8, 10, 11-18, and 20-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Baerlocher et al (US 6,648,754)

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Regarding at least claim 1, Baerlocher et al teaches a gaming device having a game comprising:

A plurality of values greater than zero (See grid figure 4b);

A plurality of player selectable masked selections (Elements 108a-108x);

A display device (Figure 1, Elements 30, 32); and

A processor adapted to communicate with the display device (Figure 2), said processor and said display device adapted to:

- (a) associate said values with said selections (Col 6:47-51);
- (b) enable a player to select one of said selections (Col 6:47-51);
- (c) reveal the value associated with the selected selection to the player (Col 6:47-51);
- (d) enable the player to accept or reject the revealed value (Col 6:52-63); and
- (e) repeat steps (a) through (d) at least once if said player rejects said revealed value, wherein if the player rejects said revealed values, said revealed value is re-

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associated with one of said masked selections for at least one subsequent selection (Col 10:30-44).

Regarding claims **2-3**, the plurality of values are randomly selected and associated with game selections (Col 7:40-61) from a pool of values wherein the “pool” of values may well include all tangible game values.

Regarding claims **4, 7** and **9**, Baerlocher shows in the grid of figure 4b a number of values equal to the number of selections. Wherein a step number is associated with each possible selection shown and the instant language “number of values” is met by the multiple presentation of a single value (Figure 23, Element 108. “23”). Additional claim language in claim 9 stating “each said value” is not equivalent to “each unique value” and hence fails to separate from the prior art of Baerlocher.

Regarding claim **5**, Baerlocher may be considered alternatively to teach the inclusion of a number of values greater then the number of selections in the realization of “the present invention includes not associating or placing one or more possible steps” (Col 7:45-50).

Regarding claims **6** and **10**, Baerlocher may be considered alternatively to teach the inclusion of a number of values less then the number of selections. Wherein a step number is associated with each possible selection shown in figure 4b contains the use of repeated specific values such as the number 23 (Col 7:40-60). Hence as understood this can be interpreted as a number of unique values less then the number of selections.

Regarding claim **8**, Baerlocher teaches the re-association (reshuffling) of values with selection after the user rejects one selection (Col 10:29-44).

Regarding at least claim **11** and in addition to the above, Baerlocher et al teaches a gaming device having a game comprising:

- A plurality of values greater than zero (See grid figure 4b);

- A plurality of player selectable selections (Elements 108a-108x);

- A display device (Figure 1, Elements 30, 32); and

- A processor which communicates with the display device (Figure 2), associates said values with said selections wherein each selection is associated with one of said value (Figure 4), displays to a player the association between at least one of the values associated with one of the selections and said selection (Figure 5D), causes the display device to display a rearrangement (reshuffling) of the selectable selections wherein after the rearrangement of the selectable selections on the display each selection remains associated with said previously associated value, enables the player to select one of the selections, and provides the player the value associated with the selection (Col 10:36-44).

Regarding claim **15**, Baerlocher et al teaches the random determination of the value associated with said selections prior to enabling their selection by the player (See Element 108 in figures 4b & 5c).

Regarding claims **18** and **21**, Baerlocher et al teaches a method for operating a gaming device including the triggering a gaming device (Col 4:15-29), associating a plurality of non-zero values with a plurality of selections (Col 7:40-46), displaying said plurality of selections (Figure 4), revealing the value associated with one of the selections picked by the player(Figure 5b), allowing the player to accept or reject the value, providing the value to the player if the player accepts the value or the selection is the last selection, and when the player selection is not their last selection/pick repeating the above if the player rejects the value including re-associating the rejected value into one of the possible selections for a subsequent selection (Col 10:36-44). Baerlocher further allows for the “reshuffling” of the steps and their associated order (Col 10:36-44) , which in turn is understood as the claimed rearrangement of the selections wherein each selection remains associated with said previously associated value.

Regarding claim **20**, the apparatus/method of Baerlocher teaches revealing a singular value associated with each selection and hence this singular value must represent the maximum and minimum offer (Figure 4).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.



The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims **12-14**, and **16-17** are rejected under 35 U.S.C. 103(a) as being obvious over Baerlocher et al (US 6,648,754)..

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned

by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(I)(1) and § 706.02(I)(2).

Baerlocher et al teaches the display of the values associated with the player selection as well as the determination of these values prior to player selection (Figures 4 & 5) however, Baerlocher appears to be silent regarding the display of these values including the values associated with non-chosen player selections, the maximum value associated with the selections, the minimum value associated with the selections, *prior* to the selection by the player. It would have been obvious to one of ordinary skilled in the art at the time of invention to have to have displayed the values listed above prior to user selection in order build player anticipation prior to the selection and further to display the non-chosen selections in order to ensure player trust in the fairness of the game.

Regarding claims 16, Baerlocher is silent regarding the partial display of selection values however, it would have been obvious to one of ordinary skill in the art at the time of invention to have only displayed a portion of the values associated with said selections in order to encourage a player to choose a safer small values with less risk at the price of a smaller payout.

Regarding claims 17, Baerlocher is silent regarding allowing a user to cause the re-revealing of the selections prior to user selection however, it would have been obvious to one of ordinary skill in the art at the time of invention to have allowed the player to cause re-revealing of the selections in order to allow a player view the value associations after a re-shuffle but prior to a subsequent selection.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571)272-4419. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

REM

A handwritten signature in black ink, consisting of a large, stylized capital 'J' followed by a horizontal line extending to the right.

JESSICA HARRISON  
PRIMARY EXAMINER